



EXPEDITED PROCEDURE – EXAMINING GROUP 3624

09/577,434

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	Jason May et al.	Examiner:	Charles Kyle
Serial No.:	09/577,434	Group Art Unit:	3624
Filed:	May 22, 2000	Docket No.:	2043.016US1
Title:	METHOD AND APPARATUS FOR FACILITATING ONLINE PAYMENT TRANSACTIONS IN A NETWORK-BASED TRANSACTION FACILITY USING MULTIPLE PAYMENT INSTRUMENTS		

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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Commissioner for Patents
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Alexandria, VA 22313-1450

Applicants respectfully request review of the final rejection in the above-identified application. No amendments are submitted with this request.

This request is being filed with a Notice of Appeal. The review is requested for the following reasons:

§103 Rejection of the Claims

Applicants submit that the Examiner has omitted one or more essential elements needed for a prima facie rejection under 35 U.S.C. § 103. See MPEP § 2143. In particular, the cited references do not teach or suggest all the claim elements of each rejected claim. Additionally, there is no teaching or suggestion to combine the cited references. The discussion below addresses each of these points.

Claims 1-3, 8-10 and 12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Egendorf (U.S. Patent 5,794,221) in view of The Official eBay Guide to Buying, Selling, and Collecting Just About Anything (hereinafter referred to as *eBay*). Applicants offer the following discussion to refute new assertions made in the Final Office Action mailed August 15, 2005 (hereinafter referred to as “FOA”).

Discussion of Claim 1

Claim 1 includes the following:

- performing a risk analysis pertaining to an online payment transaction between the first participant and the second participant using at least feedback information,
- the feedback information pertaining to the second participant and including information provided by peers of the second participant in the network-based transaction facility,
- the risk analysis to determine whether the second participant is qualified to use a payment instrument selected by the second participant from the at least one payment instrument acceptable to the first participant.

In rejecting claim 1, the FOA asserts, “Specifically, Egendorf discloses the use of a third party credit card transaction approval company, which performs risk analysis through steps such as checking whether available credit will be exceeded by a particular transaction or whether the card is reported stolen.” FOA at pp. 9-10. However, the FOA has grossly overstated and mischaracterized Egendorf. Contrary to the FOA’s assertion, Egendorf does not explicitly mention or even allude to performing a “risk analysis through steps such as checking whether available credit will be exceeded by a particular transaction or whether the card is reported stolen.” Instead, Egendorf discloses a provider system for facilitating transactions between vendors and customers, where the provider system can seek approval from a credit card company. Egendorf states, “Provider 2 can then send verifying information to one or both of the customer and vendor to indicate that the transaction has been approved, if approval of a third party, such as a credit card company, is required.” Egendorf at col. 5, ll. 36-39. Therefore, Egendorf merely teaches obtaining approval from a credit card company, but Egendorf does not teach any part of claim 1’s risk analysis.

The FOA goes on to admit that Egendorf does not disclose: “a risk analysis is performed based on feedback information provided by peers of the second participant.” (Emphasis added.) FOA at p. 3. Thus, the FOA looks to *eBay* for what Egendorf is lacking. *eBay* describes a mechanism for sharing a user’s feedback with other users. See *eBay* at pp. 31-35. According to

eBay, users share feedback to allow “buyers and sellers to establish a track record in the community that can be viewed by potential buyers and sellers.” *eBay* at page 31.

Applicants are unaware of any motivation to modify Egendorf’s provider system into a system for seeking approval of a customer’s transaction from a credit card company, where the credit card company has access to *eBay*-type feedback about the customer. The FOA has not identified a single passage from Egendorf, *eBay*, or any other reference that would motivate one to modify Egendorf’s provider system to use *eBay*’s feedback. Instead of providing a reference, the FOA asserts, “In this case, the incremental reputation information provided by *eBay* would provide additional ‘risk analysis’ for the transaction. One of ordinary skill in the commercial arts would recognize this, knowing that a person of good reputation would present less risk.” According to MPEP § 2144.03, “assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21.” MPEP § 2144.03 discussing *In re Zurko*, 59 USPQ2d at 1697. Therefore, Applicants request withdrawal of this rejection.

Discussion of Claims 13 and 25

Claims 13 and 25 each include features similar to those noted in the discussion of claim 1. Applicants respectfully submit that claims 13 and 25 are allowable for at least the reasons noted above.

Discussion of Claims 2-3, 8-10, 12, and 14-24

Claims 2-3, 8-10, 12, and 14-24 each depend, directly or indirectly, on one of claims 1 or 13. Applicants respectfully submit that claims 2-3, 8-10, 12, and 14-24 are allowable for at least the reasons noted above.

Discussion of Claims 4, 5-7, and 11

Claim 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Egendorf in view of *eBay* and further in view of Gifford (U.S. 6,049,785).

Claims 5-6 and 11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over

Egendorf in view of *eBay* and further in view of Watson (U.S. 5,978,780).

Claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Egendorf in view of *eBay* and further in view of Tessler (“eBay’s Deal with Wells Fargo Allows Sellers to Accept Credit”).

Each of claims 4, 5-7, and 11 depend, directly or indirectly, on one of claims 1 or 13. As noted above, Applicants submit that the FOA does not establish a *prima facie* case of obviousness vis-à-vis claims 1 or 13. To make a *prima facie* case of obviousness by combining Egendorf and *eBay* with Gifford, Watson or Tessler, one of Gifford, Watson or Tessler must provide what Egendorf and *eBay* are lacking. The Office Action does not point to a passage in Gifford, Watson, or Tessler that overcomes the issues discussed above vis-à-vis claim 1. As such, Applicants respectfully submit that the combination of Egendorf and *eBay* with Gifford, Watson or Tessler does not make a *prima facie* case of obviousness vis-à-vis claims 4, 5-7, or 11.

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Serial Number: 09/577,434

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CONCLUSION

Applicants respectfully request review of the final rejection in the above-identified application, as the Examiner has omitted one or more essential elements needed for a prima facie rejection. The Examiner is invited to telephone Applicants' attorney at 281-213-8980 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 15 day of November, 2005.

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